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AF/3683

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Balamucki, et al.
Serial No.: 10/051,821
Filed: 01/17/2002
Group Art Unit: 3683
Examiner: Kramer, Devon C.
For: SHIFT LEVER WITH COUNTERBALANCE

REPLY BRIEF

Box AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the Examiner's Answer dated March 18, 2004, please consider the following remarks. The appeal brief fee has already been paid. Any additional fees or credits may be charged or applied to Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds.

REMARKS

Appellant respectfully reiterates all of the arguments made in the Appeal Brief and in previous Office Action responses to address the Examiner's Answer. Additional arguments prepared in response to new issues raised in the Examiner's Answer are set forth below.

PATENTABILITY ARGUMENTS

A. The Rejection of Claims 1-11 pursuant to 35 U.S.C. §112, second paragraph is improper.

Rather than dispute the ordinary meaning of the term “dimension”, the Examiner appears to take issue with the breadth of its meaning. Apparently, the Examiner contends that “dimensions” includes both an “x, y, z” coordinate system as well as a polar coordinate system. As a preliminary matter, a polar coordinate system describes a location in space in two different dimensions, the radius vector and the polar angle. [American Heritage Dictionary, p. 958 (1991)]. It does not describe a coordinate system in “three different dimensions” as required by Claim 1.

Assuming, however, the Examiner intended to argue that “three different dimensions” may encompass, say a cylindrical coordinate system, Applicant does not dispute this point. The dictionary also defines this system as a three-dimension system. [American Heritage Dictionary, p. 360 (1991)]. “Three different dimensions” may encompass such systems as well as any other coordinate system that specifies a point in space uniquely. The breadth of “dimensions” is simply irrelevant to indefiniteness. What is relevant is that the dictionary supports the meaning of “dimension” to be clear to a hypothetical person possessing the ordinary level of skill in the pertinent art. [See MPEP 2171]. One of ordinary skill in the art would also understand the meaning of “dimension” within the context of the claim language itself. Indeed, a “third location different from said first location in three different dimensions” unequivocally relates to a difference in the three coordinates of space, whether they are x,y,z coordinates or the three coordinates of a cylindrical coordinate system (r, theta, z). Because Claim 1 is not

indefinite, the rejection of this claim and its dependents, Claims 2-10, under 35 U.S.C. §112, second paragraph, is improper.

B. The Rejection of Claim 21 pursuant to 35 U.S.C. §112, second paragraph is improper.

Claim 21 requires a “third location different from said first location in two different horizontal dimensions.” Here, the two different dimensions are expressly required to be “horizontal dimensions.” There can be no mistaking the meaning of this claim language because “horizontal” describes with great particularity the coordinates at issue. The Examiner simply fails to address the additional meaning offered by “horizontal” in his Answer. Because the Examiner cannot contest the clarity of “two different horizontal dimensions,” Claim 21 is separately allowable.

C. The Rejection of Claims 1-6, 8-11 and 21 pursuant to 35 U.S.C. §102(b) based on Bair (U.S. 5,758,543) is improper.

At first, the Examiner appears to contend that the term “dimension” is unsupported by the specification because Applicant shows three axes. However, there is no rejection pursuant to Section 112, first paragraph, here. In fact, no such rejection could be established because three separate coordinates (x,y,z) are clearly identified to support “three different dimensions”.

The Examiner also contends that *Bair* shows an adjustment of center of gravity of a shift lever in “three different dimensions” if one considers an adjustment made in the X direction, the Y direction, and an angle relative to the pivot to be three different

dimensions. *Bair*, however, makes no such showing and, in fact, teaches only the adjustment of gravity in the forward direction. [*Bair*, Column 4, ll 36-40].

Moreover, the Examiner miscounts the dimensions. An angle relative to the pivot is, in fact, a combination of the X direction and the Y direction, and not a different dimension as required by the claim language. The Examiner improperly applies a polar coordinate system to *Bair*. There is no such teaching here, because *Bair* shows a Cartesian coordinate system, not a polar coordinate system. Even if one were to ascribe a polar coordinate system to *Bair*, one could not escape the fact that *Bair* would only show an adjustment in two different dimensions (radius, theta), not three different dimensions, e.g. (radius, theta, z) or x,y,z. For these reasons, Claims 1-6, 8-11 and 21 are in condition for allowance.

D. The Rejection of Claim 4 pursuant to 35 U.S.C. §102(b) based on Bair (U.S. 5,758,543) is improper.

Claim 4 depends on Claim 1, which requires a total center of mass at a third location “different from said first location in three different dimensions.” Claim 4 further specifies that the total center of mass is “located between said first vertical location and said second vertical location.” *Bair* fails to show both of these limitations. Therefore, Claim 4 is in condition for allowance.

E. The Rejection of Claim 5 pursuant to 35 U.S.C. §102(b) based on Bair (U.S. 5,758,543) is improper.

Claim 5 depends upon Claim 4 and further requires “said total center of mass is vertically located closer to said pivot than said first vertical location.” *Bair* does not show this limitation in combination with the limitations of Claim 4. Therefore, Claim 5 is allowable.

F. The Rejection of Claim 6 pursuant to 35 U.S.C. §102(b) based on Bair (U.S. 5,758,543) is improper.

Claim 6 requires the adjustment of the center of mass in both a horizontal direction and a vertical direction. The Examiner contends that *Bair* shows this feature, arguing that *Bair* describes a counterbalance “at a location offset from the shift lever in the horizontal direction.” The Examiner fails to identify any such portion of *Bair* to support this position. Indeed, Figure 5 of *Bair* illustrates a counterbalance receiving a shift lever at cavities 60,62, which are located in the center of the balance, not offset as the Examiner argues. Therefore, Claim 6 is in condition for allowance.

G. The Rejection of Claim 21 pursuant to 35 U.S.C. §102(b) based on Bair (U.S. 5,758,543) is improper.

Claim 21 requires the total center of mass to be at a third location, which is different from said first location in two different horizontal dimensions. The Examiner contends that this limitation is met by *Bair* because the center of gravity is moved in a forward direction and by an angle relative to the pivot. *Bair* does not show a total center of mass at any angle relative to any pivot. Moreover, the Examiner fails to show how

Bair teaches two different “horizontal” dimensions. As noted above, the balance of *Bair* is shown to be horizontally symmetrical with the shift lever located at the balance’s center. There can be no adjustment in two different horizontal directions. Accordingly, Claim 21 is allowable over *Bair*.

H. The Rejection of Claims 1, 7-9 and 21 pursuant to 35 U.S.C. §102(b) based on Onoguchi et al (JP 3134367) is improper.

The Examiner also relies upon *Onoguchi et al* (JP 3134367). Apparently, the Examiner contends that lever 16 is offset by a so-called counterweight 18. However, element 18 is mounted to structure 14, which appears to be mounted to a frame. Therefore, it is unclear what effect, if any, element 18 has on lever 16. For this reason, Applicant reminded the Examiner of the need for a translation to understand the effect of element 18 on lever 16. Indeed, there is nothing understandable within *Onoguchi et al.* that shows an adjustment of the center of gravity in three different dimensions. In fact, the pictures of *Onoguchi et al.* illustrate element 18 to be in the same plane (the plane of the page) and hence to have the same two dimensions as lever 16. For this reason, Claims 1 and 7-9 are allowable.

I. The Rejection of Claim 7 pursuant to 35 U.S.C. §102(b) based on Onoguchi et al (JP 3134367) is improper.

The Examiner contends item 14 to be “some type of elastomeric member.” Yet, the Examiner fails to identify his support for this conclusion. For this reason, the rejection of Claim 7 is improper. Claim 7 is separately allowable.

J. The Rejection of Claim 21 pursuant to 35 U.S.C. §102(b) based on Onoguchi et al (JP 3134367) is improper.

The Examiner offers no additional support for his rejection of Claim 21. The so-called "counterbalance", item 18, appears as symmetric relative to lever 16 as the counterbalance of *Bair*. For this reason, *Onoguchi* et al. does not appear to adjust the center of mass of lever 16 in two different horizontal dimensions. Accordingly, Claim 21 is separately allowable

CONCLUSION

For the reasons set forth above and in the Appeal Brief, the rejection of all claims is improper and should be reversed.

Respectfully submitted,

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Dated: May 17, 2004

CERTIFICATE OF MAILING

I hereby certify that the enclosed **Reply Brief (in triplicate)** is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on May 17, 2004.


Theresa M. Palmateer

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